

REMARKS/ARGUMENTS

Favorable reconsideration of this application, in view of the present amendment and in light of the following discussion, is respectfully requested.

Claims 1 and 3-16 are pending. Claims 4, 6, and 10-13 were withdrawn by the outstanding Office Action. In the present amendment, Claim 1 is currently amended. Support for the present amendment can be found in the original specification, for example, at page 5, lines 6-9 and in original Figures 1a, 1b, 2a, 2b, 2c, and 2d. Thus, it is respectfully submitted that no new matter is added.

In the outstanding Office Action, Claims 1, 3, 5, 7-9, and 14-16 were rejected under 35 U.S.C. § 103(a) as unpatentable over Kobayashi et al. (WO 03/007752, hereinafter “Kobayashi”).

Regarding Applicants claim to foreign priority, the Office Action again states that “Japan 2004-008099 does not appear to be related to application 10/560,044 therefore it will not receive the foreign priority date 1/15/2004.” However, Applicants respectfully submit that the present application is directly related to Japanese Application No. 2004-008099 (Publication No. 2005-198827), which is titled “Hair Holder” and has the same inventive entity. Thus, it is respectfully requested that the present application receive the foreign priority date of January 15, 2004. If the Office maintains the position that Japanese Application No. 2004-008099 (Publication No. 2005-198827), which is titled “Hair Holder” and has the same inventive entity as the present application, does not appear to be related to application 10/560,044, ***please explain*** why they do not appear to be related so that Applicants may respond accordingly.

In response to the rejection under 35 U.S.C. § 103(a), Applicants respectfully request reconsideration of this rejection and traverse this rejection, as discussed below.

Amended Claim 1 recites a hair holder, comprising “a flat tube having a sheet which forms a first side and a sheet which forms a second side to allow a hair bundle to be inserted from an opening at one end of the tube toward an opening at an other end thereof such that, when the hair holder is rolled up, the sheet which forms the first side is on an outside of the tube.” Additionally, “the sheet which forms the second side of the tube has a Taber stiffness of 0.4 mNm or higher, and the sheet which forms the first side has an extensibility of at least 15 times an extensibility of the sheet which forms the second side under a load of 5 N.” It is respectfully submitted that the cited reference does not disclose or suggest every feature recited in amended Claim 1.

Kobayashi describes a hairdressing tool formed of two rectangular sheets and having substantially no extensibility as a whole.¹ Further, Kobayashi describes that, as long as a tube has substantially no extensibility as a whole, part of the sheet(s) forming the tube may have extensibility.²

The Office Action, in the second paragraph on page 6, concedes that Kobayashi does not disclose “the first side of the sheet having at least 15 times higher of an extension under a load of 5N as of the second sheet.” Instead, the Office Action asserts that such a ratio of extensibility between the first and second sheet would have been obvious to one having ordinary skill in the art at the time of the invention “since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.”

However, it is respectfully submitted that a person of ordinary skill in the art reading Kobayashi would not have found discovering the claimed ranges to be routine, as discussed below.

¹ See Kobayashi, at paragraph [0132] of U.S. Publication No. 2004/0231689, which is the national stage application of WO 03/007752.

² See Kobayashi, at paragraph [0133].

Kobayashi describes that the sheet 223B (which is difficult to extend) has a Taber stiffness of more than 0.4 mNm.³ Kobayashi also describes that it is preferably rolled with the sheet 223A (which is easy to extend) of low Taber stiffness inward.⁴

On the other hand, in the hair holder recited in amended Claim 1, the tube having a hair bundle H inserted therethrough is rolled up with the sheet which forms the first side (which is easy to extend) out. That is, the sheet which forms the first side (which is easy to extend) of the claimed invention is arranged *opposite* to the side of the sheet 223A (which is easy to extend) of Kobayashi.

By arranging the sheet which forms the first side (which is easy to extend) on the outer side of the tube as recited in amended Claim 1, and the sheet which forms the second side (which is difficult to extend) having a Taber stiffness of 0.4 mNm or higher on the inner side, the hair holder induces the proper “tension” to be exerted to the hair inserted through the tube upon being rolled up. This allows for easily and surely providing the hair with an orderly curl as described in the original specification, for example, at page 6, lines 13-15.

Kobayashi does not disclose or suggest the application of tension to a hair bundle. In addition, Kobayashi does not disclose positively arranging the sheet which is easy to extend on the outer side, but instead arranges the sheet on the inner side.

Accordingly, Applicants respectfully submit that a person of ordinary skill in the art reading Kobayashi would not have found discovering the claimed ranges to be routine as Kobayashi teaches away from having the sheet with the Taber stiffness of 0.4 mNm or higher on the inner side. On the contrary, Kobayashi describes that the sheet 223A which is easy to extend is positioned on the inside when being rolled up, and thus does not recognize the general condition of relationship between the Taber stiffness and the ability to extend required to be on the outside of the rolled up hair holder.

³ See Kobayashi, at paragraph [0132].

⁴ See Kobayashi, at paragraph [0130].

Thus, it is again respectfully submitted that it would not have been obvious to a person of ordinary skill in the art reading Kobayashi to have the claimed ratio of extensibility since Kobayashi does not recognize the ratio of extensibility as a result-effective variable to be optimized. See MPEP 2144.05 II.B. Further, since Kobayashi describes that as long as a tube has substantially no extensibility as a whole, part of the sheet(s) forming the tube may have extensibility, Kobayashi teaches away from the claimed extensibility ratio.

Therefore, it is respectfully submitted that Kobayashi does not disclose or suggest every feature recited in amended Claim 1. Thus, it is respectfully requested that the rejection of Claim 1, and all claims dependent thereon, as unpatentable over Kobayashi be withdrawn.

Independent Claim 8 recites, *inter alia*, a method of treating hair, including employing a hair holder in which “the sheet which forms the second side of the tube has a Taber stiffness of 0.4 mNm or higher, and the sheet which forms the first side has an extensibility of at least 15 times an extensibility of the sheet which forms the second side under a load of 5 N... and rolling up the tube having the hair therein with the first side thereof facing out.”

Therefore, in view of the discussion of Kobayashi with respect to Claim 1, it is respectfully submitted that Kobayashi does not disclose or suggest every feature recited in Claim 8. Thus, it is respectfully requested that the rejection of Claim 8, and all claims dependent thereon, as unpatentable over Kobayashi be withdrawn.

Consequently, in view of the present amendment, no further issues are believed to be outstanding in the present application, and the present application is believed to be in condition for formal allowance. A Notice of Allowance is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Richard L. Chinn
Attorney of Record
Registration No. 34,305

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 08/07)

Colin B. Harris
Registration No. 58,969